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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/559,400

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John C. Opie

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SQUIRE SANDERS & DEMPSEY LLP
TWO RENAISSANCE SQUARE, 40 NORTH CENTRAL AVENUE
SUITE 2700
PHOENIX, AZ 85004-4498

EXAMINER

KIDWELL, MICHELE M

ART UNIT

PAPER NUMBER

3761

MAIL DATE

DELIVERY MODE

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/559,400	Applicant(s) OPIE ET AL.	
	Examiner Michele Kidwell	Art Unit 3761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>7/19/07;12/12/07</u> . | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this

Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1 – 13, 15 – 16, 18 – 21, 23 – 24 and 26 – 28 are rejected under 35 U.S.C. 102(b) as being anticipated by Yarger (US 4,867,747).

With reference to claims 1 – 2 and 4 – 9, Yarger discloses a surgical drain comprising and elongate, flexible body (col. 4, lines 36 – 38) comprising: (a) a longitudinal axis; (b) an interior lumen; (c) an outer surface; (d) an opening for connection to an outflow tube (23); (e) a first plurality of openings (18) formed in the outer surface and extending along the longitudinal axis, at least some of the first plurality of openings in fluid communication with the interior lumen; and (f) a second plurality of openings (30) formed in the outer surface, each of the second plurality of openings having a different shape and size than the openings of the first plurality of openings with at least some of the second plurality of openings and/or a first plurality of openings comprising alternating large cross sectional openings and small cross sectional openings as set forth in figure 4.

As to claim 3, the examiner considers the openings between elements 32 as being rectangular shown in figures 5 – 7.

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As to claim 10, see figures 5 – 6.

Regarding claim 11, Yarger discloses a drain wherein the opening (22) is at an end of the drain as set forth in figure 7.

With reference to claim 12, see figure 7.

As to claim 13, Yarger discloses a surgical drain system as set forth in col. 3, lines 19 – 24.

With reference to claims 15 and 16, Yarger discloses a surgical drain comprising: (a) an outer surface comprising a generally flat bottom surface and a generally flat top surface and two side surfaces connecting the top surface and the bottom surface, an internal lumen, (b) circular openings in the top surface; and (c) non-circular rectangular openings in one of the side surfaces as set forth in figure 7. The examiner considers the openings between elements 32 as being rectangular shown in figures 5 – 7.

As to claims 18 – 21 and 26 – 28, see figures 4 – 7.

With reference to claim 23, Yarger discloses a surgical drain having an outer surface, an interior lumen, and a channel formed in the outer surface, the channel for impeding the in-growth of bodily tissue therein, and one or more openings formed at least partially in the base of channel, the openings in fluid communication with the interior lumen as set forth in figures 4 – 7.

As to claim 24, Yarger discloses four channels in figure 7.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14, 17, 22, 25 and 29 – 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yarger (US 4,867,747).

The difference between Yarger and claim 14 is the provision that the surgical drain system further comprises a reservoir.

It would have been obvious to one of ordinary skill in the art to provide the drain system with a reservoir in order to collect waste materials.

The difference between Yarger and claim 17 is the provision that the circular openings have a specific diameter.

It would have been obvious to one of ordinary skill in the art to modify the diameter of the openings of Yarger in order to determine the most effective product because Yarger discloses that modifications of the apertures are within the scope of the invention as set forth in col. 7, lines 8 – 12.

The difference between Yarger and claim 22 is the provision that the lumen has a specific diameter.

It would have been obvious to one of ordinary skill in the art to modify the lumen of Yarger in order to determine the most effective product since it has

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been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable range involves only a level of ordinary skill in the art. Likewise, Yarger discloses that modifications of the apertures are within the scope of the invention as set forth in col. 7, lines 8 – 12.

The difference between Yarger and claim 25 is the provision that the channel has a specific depth.

It would have been obvious to one of ordinary skill in the art to modify the depth of the channel of Yarger in order to determine the most effective product because Yarger discloses that modifications of the apertures are within the scope of the invention as set forth in col. 7, lines 8 – 12.

With reference to claims 29 – 30, it would have been obvious to one of ordinary skill in the art to modify the channels of Yarger in order to determine the most effective product because Yarger discloses that modifications of the apertures are within the scope of the invention as set forth in col. 7, lines 8 – 12.

Double Patenting

Claims 1 – 30 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1 – 30 of copending Application No. 10/863,009. Although the conflicting claims are not identical, they are not patentably distinct from each other because both the instant application and copending Application No. 10/863,009 are directed to a surgical drain with first and second openings with the second openings having a different shape and size than the first openings.

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This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michele Kidwell whose telephone number is 571-272-4935. The examiner can normally be reached on Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tatyana Zalukaeva can be reached on 571-272-1115. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michele Kidwell/
Primary Examiner, Art Unit 3761